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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,443	08/21/2001	Lawrence D. Weiss	374.37564X00	3764

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EXAMINER

NELSON, FRED A ANN

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,443

Applicant(s)

WEISS ET AL.

Examiner

Freda A. Nelson

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☒ Claim(s) 23 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3639

DETAILED ACTION

This is in response to the communication filed on October 24, 2001. Claims 1-24 are currently pending.

Claim Objections

1. Claims 23-24 are objected to because of the following informalities:

In claims 23-24, Line 5, respectively, insert "image" before "reflects".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 8 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claims 8 and 18, the examiner is unable to determine how the system determines how much a customer "should pay".

Art Unit: 3639

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 recites the limitation "the purchase" and "the consumer's needs" in lines 6 and 8, respectively. There is insufficient antecedent basis for these limitations in the claim.

4. Claim 2 recites the limitation "the group" in line 2. There is insufficient antecedent basis for this limitation in the claim.

5. Claims 5-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 5-6 are incomplete

6. Claim 8 recites the limitation "the purchase" in line 6. There is insufficient antecedent basis for these limitations in the claim.

7. Claim 9 recites the limitation "the user" and "the appropriate time" in lines 3-4, respectively. There is insufficient antecedent basis for these limitations in the claim.

8. Claim 13 recites the limitation "the single integrated" in line 2. There is insufficient antecedent basis for these limitations in the claim.

9. Claims 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 16-17 depend on claim 8, a system. However, the preamble of claims 16-17 define a method.

10. Claim 18 recites the limitation "the purchase" in line 5. There is insufficient antecedent basis for these limitations in the claim.

11. Claim 21 recites the limitation "the purchase" in line 5. There is insufficient antecedent basis for these limitations in the claim.
12. Claim 23 recites the limitation "the database" in line 2. There is insufficient antecedent basis for these limitations in the claim.
13. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim depends on claim 21, a method. However, the preamble of claim 23 defines a system.

Double Patenting

14. Claims 1-24 are provisionally rejected under the judicially created doctrine of double patenting over claim 1-24 of copending Application No. 09/807,444. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

a system for advising a consumer how much to pay for goods and services comprising:

- a user interface for allowing a customer to access a host
- computer via an on-line network,
- a host computer which solicits a consumer's objective and

subjective criteria for the purchase of goods or services in an interactive, intuitive manner, wherein based on the consumer's needs and access to available data on goods or services, the system generates at least one of options, recommendations, referrals to providers of goods or services, and prices of goods or services, and means for presenting information to the customer.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. (Patent Number 6,249,772).

In claim 1, Walker et al. disclose that user computer 102 is coupled to network which is a line such as a telephone line, an ISDN line, or a modem line or may be any other network connection or line (e.g., T1 or T3) that will allow data communications between a network and a host terminal (col. 8, lines 57-62). Walker et al. further disclose a system for facilitating the sale and distribution of products that includes a data storage system maintaining information related to products including sellers of and prices for the products, and a data processing system operatively coupled to the data storage system wherein the data processing system is configured to receive a request from a buyer to acquire a product, to process the request by querying the data storage system to identify a purchase price and a seller to sell the product to the buyer at the purchase price, to send a notice to the buyer indicating the seller and the purchase price, to receive from the buyer a purchase request including an account identifier identifying an account to be updated based on the purchase price, and to send a purchase confirmation notice to the buyer indicating that the buyer can acquire the product from the seller at the purchase price (col. 5, lines 37-51).

Art Unit: 3639

16. In claim 2, Walker et al. disclose that PEAPOD is an example of an Internet subscription grocery service wherein orders placed over the net are, for a fee, filled by PEAPOD and delivered from a local grocery (col. 3, lines 49-52).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (Patent Number 6,249,772) in view of Denman (Patent Number 5,737,729).

18. In claim 3, Walker et al. does not disclose that the services to be purchased are postal services and the goods to be purchased are postal goods. Denman discloses an interactive kiosk for purchasing and sending post cards or other mail pieces (col. 2, lines 27-28). It would have been obvious to one of ordinary skill in the arts at the time the invention was made to modify the invention of Walker et al. to include the feature of Denman et al. in order to provide an interactive kiosk that allows an individual to select and send post cards or mail pieces at one location without worrying about finding another location for buying the appropriate postage or finding a mailbox (Denman; col. 1, lines 58-63).

Art Unit: 3639

19. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (Patent Number 6,249,772) in view of Tagawa (Patent Number 5,732,398).

20. In claim 4, Walker et al. does not disclose that the services to be purchased are telephone services or airlines services. Tagawa discloses a self-service method of selling travel-related services or products such as local tour attractions, local bookings, car rental bookings, local or intrastate tour packages, airline tickets, out-of-state tour packages, cruises, optional tours or cruises, and other shopping options (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Walker et al. to include the feature of Tagawa in order to sell travel-related services or products by means of an interactive travel service system functioning like a travel agent, to simplify the search process by the system and the decision process by the user (Tagawa; abstract).

21. Claims 7-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melchione et al. (Patent Number 5,930,764).

22. In claim 7, Melchione et al. disclose that the workstations utilize the central database to provide information for on-line viewing and report generation through selection of customers or accounts matching given criteria and producing matches with selected data elements (col. 58, lines 50-55); sessions are used to meet with the customer, to discuss the customer's management needs, and to offer products and services to satisfy the customer's needs (col. 15, lines 39-42); the system includes a means for walking users through each step of building a search request (col. 27, lines 13-14); a means inputting a customer's component selection (col. 10, lines 14-15); a

Art Unit: 3639

means for performing a needs analysis based on the data collected (col. 10, lines 12-13); means for making recommendations based upon the needs assessment; and a means for displaying account information (col. 10, lines 13-14).

23. In claims 8 and 17, Melchione et al. disclose a means for collecting data concerning customer's financial and/or investment situation (col. 10, lines 10-12); a means for adding account components to a single account to build a single account (col. 10, lines 16-18); a means inputting a customer's component selection (col. 10, lines 14-15); a means for performing a needs analysis based on the data collected (col. 10, lines 12-13); means for making recommendations based upon the needs assessment (col. 10, lines 12-13); a means for displaying account information (col. 10, lines 13-14); and a means for linking data fields in each component such that once a piece of data is collected, the data is provided to all appropriate fields (col. 10, lines 26-28).

24. In claim 9, Melchione et al disclose that the user may elect not to provide certain information if in her or his judgment, the customer should not be asked to provide the information at that time. Thus, data input will not be required at this step, but some record is made if this step is bypassed so that data can be collected later (col. 47, lines 17-22).

25. In claim 10, Melchione et al disclose that the system of the present invention includes a "pending file" for storing information that is collected, but not immediately needed (col. 47, lines 29-31).

26. In claim 11, Melchione et al. disclose a system that permits data to flow up and

down through the process so that once a salient piece of data is collected, the data is transmitted to every location where it is needed (col. 10, lines 38).

27. In claims 12-15, Melchione et al. disclose that the use of the bank statement motif for the account building display is an important part of this invention and is in accord with the underlying objective of presenting a consistent interface to customers wherein the display shows what the customers bank statement looks like before the account is built. Core components such as checking, savings, IMMA, CD's, retirement, brokerage, line of credit and credit card are included in the example (col. 50-lines 36-43). Melchione et al. further disclose that if the user elects to build a secured credit component, the system will follow the flow shown in FIG. 13J (col. 53, lines 32-33).

28. In claim 16, Melchione et al. disclose that the central database may include information concerning existing customer financial information, information from outside sources, and demographic information about existing and potential customers (col. 7, lines 61-66).

29. In claims 18-20, Melchione et al. disclose a system for opening an account (col. 10, lines 9-10); the central database may include information concerning existing customer financial information, information from outside sources, and demographic information about existing and potential customers (col. 7, lines 61-66); a system that provides Marketing personnel with a dynamic view of a customer's financial and demographic profile during a marketing session (col. 6, lines 4-7); a means for identifying missing data and means for prompting the user to enter data that has not been provided (col. 10, lines 23-24); a means inputting a customer's component

Art Unit: 3639

selection (col. 10, lines 14-15); a means for performing a needs analysis based on the data collected (col. 10, lines 12-13); means for making recommendations based upon the needs assessment; a means for displaying account information (col. 10, lines 13-14); and a means for linking data fields in each component such that once a piece of data is collected, the data is provided to all appropriate fields (col. 10, lines 26-28).

30. In claims 21-24, Melchione et al. disclose a means for adding account components to a single account to build a single account (col. 10, lines 16-18); the central database may include information concerning existing customer financial information, information from outside sources, and demographic information about existing and potential customers (col. 7, lines 61-66); a means for performing a needs analysis based on the data collected (col. 10, lines 12-13); means for making recommendations based upon the needs assessment; a means for displaying account information (col. 10, lines 13-14); a means for making recommendations based upon the needs assessment (col. 10, lines 12-13); most fields in the central database are preferably updated monthly with information captured at month end (col. 7, lines 56-58); and a means for updating the display of facsimile representation of a customer's bank statement (col. 44, lines 1-3).

Conclusion

31. The examiner has cited prior art of interest, for example:

1) Gifford (Patent Number 6,205,437), which discloses an open network payment system for providing for real-time authorization of payment and purchase transactions.

Art Unit: 3639

2) Pricescan.com

3) Blankenhorn et al., "Web Malls Add Online Purchasing", May 1997, Advertising Age's Business Marketing, Vol. 82, Issue 4.

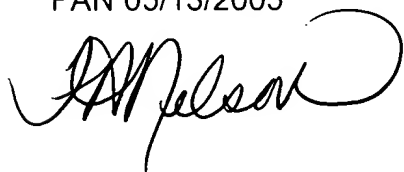
4) Miaolovich, Jill, "QuickXpense introduces automatic pre-population of expense reports", May 08, 1995, Business Wire. New York, Sec. 1, pg. 1.

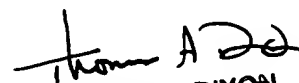
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FAN 05/13/2005




THOMAS A. DIXON
PRIMARY EXAMINER